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04 MAY 1995

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In re Application of :
Kurt NILSSON et al :
Application No.: 08/356,229 : DECISION
Filing Date: 19 December 1994 :
For: IMMobilized CARBOHYDRATE :
BIOSENSOR :
:

The above-identified application is before the PCT Legal Office for review of the filing status.

BACKGROUND

On 18 April 1994, applicants filed international application PCT/SE94/00343, which claimed priority of a Swedish application 9301270-6 filed 19 April 1993. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 27 October 1994. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 19 December 1994.

On 19 December 1994, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); and an English translation of the international application as required by 35 U.S.C. 371(c)(2). An oath or declaration as required by 35 U.S.C. 371(c)(4) was not filed.

On 09 January 1995, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration and the surcharge for filing the oath or declaration later than 20 months from the priority date as required by 37 CFR 1.492(e) must be filed. The notification set a one month time limit in which to respond.

On 06 February 1995, applicants filed a declaration executed by the inventors, the required surcharge, a certified copy of the Swedish priority document, a small entity form and a request for a refund of one-half of the basic national fee.

DISCUSSION

In a communication (PCT/IB/345) dated 28 October 1994, the International Bureau (IB) informed applicant that the priority date indicated in Box VI of the REQUEST did not agree with the priority date on the priority document. The IB noted that the 17-month period for correction had passed and therefore, the IB would not record a rectification. The IB sent a copy of the communication to each of the designated Offices.

A review of Swedish application 9301270-6 reveals that its filing date is 17 April 1993. The international applicant is considered to be filed within one year of the Swedish application since 17 April 1994 was a Sunday.

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which section of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

A review of the application papers reveals conflicting and/or ambiguous instructions as to which section of the statute applicants intended this application to be filed under in the U.S. For example, reference is made to applicants' "LETTER ACCOMPANYING NATIONAL STAGE REQUIREMENTS" filed on 19 December 1994, in which (on page one), applicants stated the following:

"The accompanying documents are being filed in accordance with 35 USC § 371. The undersigned has not received a copy of the PCT Form 308 or a copy of the original Swedish language PCT application. Box 5(b) on the PCT National Stage Transmittal form has been checked off on the belief that the International Authority properly forwarded a copy of the original Swedish language application to the designated U.S. Patent and Trademark Office. If,

however, the International Authority did not forward a copy of the original Swedish language application to the U.S. Patent and Trademark Office, rather than having the application go abandoned, Applicants request that this filing be considered as an incomplete continuation filing under 35 USC § 111 and the enclosed fees used for that purpose."

From the above-quoted statement it is unclear whether applicants clearly and unambiguously desires to have this application treated under Section 371(c) or Section 111 of the Statute. Therefore, since this application is deemed to contain conflicting instructions as to which section of the statute (371 or 111) applicant intended the application to be filed under, it is appropriate, pursuant to the O.G. Notice referenced above to treat this application as being filed under 35 U.S.C. 111.

Section (c)(2) of 35 U.S.C. 371 states the following:

- (c) The applicant shall file in the Patent and Trademark Office--
 - (1) the national fee provided in section 41(a) of this title;
 - (2) a copy of the international application, unless not required under subsection (a) of this section or already communicated by the International Bureau, and a translation into the English language of the international application, if it was filed in another language;

PCT Rule 47.1(c) states, in part, the following:

"The International Bureau shall send a notice to the applicant indicating the designated Office to which the communication has been effected and the date of such communication. . . . The notice shall be accepted by all designated Offices as conclusive evidence that the communication has duly taken place on the date specified in the notice."

The International Bureau mails a confirmation (Form IB/308) to applicants upon which applicants can reply that the copy has been provide.

From the above quoted Statute it is clearly the applicants' responsibility to ensure that a copy of the international application is in the file. Applicants can rely on the notice from the International Bureau that such communication has taken placed.

Applicants are entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 08/356,229) and the international application (PCT/SE94/00343) designating the United States were copending on 19 December 1994. To obtain benefit of the earlier

international application, applicants must amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is a continuation of international application PCT/SE94/00343, filed 18 April 1994, which designated the United States and is now abandoned."

REQUEST FOR A REFUND

Applicants have filed a request for a refund and a small entity statement within two months of the payment of the basic national fee. Accordingly, applicants are entitled to a refund of one-half the basic national fee. Applicants' Deposit Account No. 02-4300 has been credited with \$425.00.

CONCLUSION

This application is accepted as an application filed under 35 U.S.C. 111 with a filing date of 19 December 1994.

This application is being forwarded to the International Division for removal of the papers communicated from the International Bureau to the United States Patent and Trademark Office concerning international application PCT/SE94/00343.

The application will then be forwarded to the Application Processing Division for processing as a national application filed under 35 U.S.C. 111 with a filing date of 19 December 1994.



Leonard E. Smith
PCT Legal Examiner
PCT Legal Office

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